

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Chang-Seob KIM et al.

Application No.: 10/748,197

Group Art Unit: 1746

Confirmation No. 6732

Filed: December 31, 2003

Examiner: Melissa Thompson

For: JELLY-ROLL TYPE BATTERY UNIT AND WINDING METHOD THEREOF AND LITHIUM
SECONDARY BATTERY COMPRISING THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed January 24, 2007, having a shortened period for response set to expire on February 26, 2007 (February 24 being a Saturday), the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect claims 1-7 and 14-26 (Invention I) in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

On page 2 of the Office Action, the Examiner asserts that inventions I and II are distinct since the battery of invention I could be made without an insulative tape. As a point of clarification, neither the independent claims of invention I nor the independent claim 8 of invention II recite the use of an insulative tape. Therefore, the Examiner's analysis does not reflect the independent claims as presented in each invention.

Additionally, insofar as inventions I and II are concerned, it is believed that claims 8-13 are so closely related to elected claims 1-7 and 14-26 that they should remain in the same application to avoid imposing any undue burden, expense, and delay on the Applicants in preserving the invention II as recited in claims 8-13. Specifically, there have further been no

references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing claims for products and methods of making the products in the same field of technology. While it is noted that the Examiner has identified different classifications for the claims of inventions I and II, it is believed that classification is not conclusive on the question of restriction.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.06, §808.01) or distinct as claimed (see MPEP §806.05-806.05(j)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §808 and §808.02). Such evidence is required in order for meaningful review to be provided under the Administrative Procedures Act, 5 U.S.C. §706. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001). As such, beyond showing separate classifications, it is respectfully submitted that the Examiner has not set forth sufficient evidence of distinctness to show that the Examiner will experience a serious burden without imposing restriction which is out of proportion with the serious burden and inconvenience visited upon the applicant if restriction is required.

III. Conclusion

Upon review of references involved in this field of technology, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney. If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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